

REMARKS

This is in response to the Office action dated January 25, 2006, in which claims 1, 3-11, 13-28, 31, and 33-43 were rejected, after claims 1, 3-11, 13-20, 22-28, 31 and 33-43 were allowed in the previous Office action. The applicant respectfully requests that claim 8 be amended merely to put its subject matter in better form for allowance. The applicant respectfully submits that claims 1, 3-11, 13-28, 31, and 33-43 are in condition for allowance, in light of the amendments and remarks herein, and respectfully requests that the rejection of these claims be withdrawn and the claims allowed.

CLAIM 12 IS NOT RENDERED OBVIOUS BY LEE AND KRUSE

Claim 12 was rejected under 35 U.S.C. 103(a) due alternately to a combination of Lee (U.S. 5,860,231) and Kruse (U.S. 3,061,117), and to the single reference of Tabor (EP. 1361312). The rejection of claim 12 due to Tabor is discussed below, together with other claims under the same basis for rejection.

The applicant submits that the rejection of claim 12 due to Lee and Kruse is not sustainable when Lee, Kruse, and claim 12 are accurately construed. In particular, it is asserted in the Office action that Lee fails to specifically disclose certain elements of claim 12, such as the activation state comprising the attachment member being selectably oriented within a predetermined segment of the range of tilt, and the attachment member undergoing a minimum load; and it is asserted that the auto-vibration of Lee can inherently occur during a predetermined segment of the range of tilt. However, this seriously misconstrues the activation state of claim 12. Regardless of the tilt or load on an attachment of a device of Lee, such a tilt or load is coincidental to the activation of the auto-vibration mode of Lee. Rather, Lee specifically teaches that the "auto-vibration" is activated with a switch, and that various aspects of the auto-vibration are controlled with control levers (e.g. col. 4, lines 21-28). Lee does not teach or suggest that any aspect of tilt or load could be conditions for an activation state for activating an automatic vibration mechanism. The activation state of the present invention is associated with conditional

parameters that are sensed and that, when fulfilled, trigger the automatic vibration mechanism, as described in the applicant's specification; for example on page 11, lines 16-25; page 14, lines 8-17; page 24, lines 4-16, etc. The automatic vibration mechanism is engaged when the conditional parameters of the activation state are met, and the automatic vibration mechanism is not engaged if the conditional parameters of the activation state are not met, as well described in the language of claim 12, and as supported by the applicant's specification. Therefore, the mere capability in the device of Lee for a given tilt and load to inherently occur, coincidentally but not with any causal relation to the manual switch-based activation of a vibration mechanism, does not disclose the specific teachings of the present claim for a predetermined tilt and minimum load to be comprised in an activation state, serving as conditional parameters for activating an automatic vibration mode.

The elements of claim 12 wherein the activation state comprises the attachment member being selectably oriented within a predetermined segment of the range of tilt, and the attachment member undergoing a minimum load, are therefore not taught or suggested by Lee or Kruse.

CLAIMS 1, 3, 5, 19, 20, 22, 25, AND 26 ARE NOT ANTICIPATED BY TABOR

Claims 1, 3, 5, 6, 8, 9, 15-20, 22, 24-27, 34-40, 42 and 43 were rejected under 35 U.S.C. 102(b) due to Tabor (EP 1361312). However, the applicant submits that the rejection of these claims is not sustainable when Tabor is accurately construed, and that Tabor does not justify withdrawing the previous allowance of these claims.

For example, certain elements of claims 1, 8, and 34 were purported to have been anticipated by the disclosure in column 9, lines 14-19 of Tabor reading, "Further, in certain alternate embodiments, the system controller 280 is capable of determining when it is necessary to enter the vibrating state automatically without receiving any command from the operator (e.g. based upon signals from one or more sensors)." However, this does not specifically disclose the subject matter of claim 1, such as wherein the attachment member being selectably oriented within the predetermined segment of the range of tilt comprised in the activation state is a

necessary condition for causing the activation signal. In particular, the passage from Tabor makes no mention of how, why or when the system controller would determine, without a command from the operator, when it is necessary to enter the vibrating state, other than based on signals from sensors. This disclosure is nothing more than an invitation to a fishing expedition of undue experimentation, rather than a disclosure of any specific elements of the present claims.

While the disclosure of Tabor might merely be consistent with the subject matter of claim 1, this in no way implies disclosure or suggestion of the specific subject matter of claim 1. One might imagine a patent from 2,000 years ago claiming communicating with a lighthouse, where alternate embodiments are broadly disclosed to create a signal conveyed by visible light. This would be consistent with communicating with laser signals over fiberoptic lines, but that would not imply that it anticipated communicating with laser signals over fiberoptic lines. The mere disclosure of unelaborated signals from sensors triggering an automatic option for a vibrating state does not disclose or suggest the specific elements of claim 1. Tabor simply does not disclose any specific conditions for how or why a system controller would be able to determine when to enter the vibrating state, or what signals might be sent from what manner of sensors in response to what sensed conditions. The element wherein the attachment member being selectably oriented within the predetermined segment of the range of tilt comprised in the activation state is a necessary condition for causing the activation signal, is very different from, and is not anticipated by, the mere disclosure of generic signals from unnamed sensors without any further elaboration.

For at least this illustrative reason, claims 1, 8, and 34 are not anticipated by the cited references and are in condition for allowance. The applicant requests that the examiner withdraw the rejection and allow these claims.

Claims 3, 5, 19, 20, 22, 25, and 26 are dependent on claim 1; claim 6 is dependent on claim 5; claims 9, 15, 17, 18, 24, and 27 are dependent on claim 8; claim 16 is dependent on claim 15; and claims 35-40 and 42-43 are dependent on claim 34. Due at least to each of these dependent claims incorporating the allowable subject matter of claims 1, 8, and 34, respectively, the applicant submits that these claims are also in condition for allowance.

These dependent claims also have additional reasons for being allowable due to their own subject matter. For example, claims 3, 6 and 9 were rejected because the Office action purported that in Tabor, the system also has a predetermined length of time, comprised in the activation state as recited. However, a close reading of Tabor shows that its disclosure is very different from the subject matter of claims 3, 6 and 9. Specifically, Tabor discloses (column 9, lines 5-8) that after entering the vibrating state, the system controller 280 remains in the vibrating state for a predetermined period of time (or for a predetermined number of vibrations) and then automatically shuts off. In sharp contrast, claims 3, 6 and 9 disclose wherein the system also has a predetermined length of time, comprised in the activation state, for the attachment member to be oriented within the predetermined segment of the range of tilt and/or lift, respectively, wherein the attachment member being oriented within the predetermined segment of the range of tilt and/or lift, respectively, for the predetermined length of time is a further necessary condition for causing the activation signal. For the vibrating state to persist for a predetermined period of time, from when the vibrating begins until the vibrating shuts off, as in Tabor, is very different from and does not anticipate the vibrating state not being triggered or begun until after the attachment member is oriented within a predetermined segment of the range of tilt and/or lift, respectively, for a predetermined length of time, after which the vibrating state begins, as in claims 3, 6 and 9. These are substantial differences, and represent novel advantages in the inventions of claims 3, 6 and 9 over the disclosure of Tabor.

Therefore, for at least this additional illustrative reason, claims 3, 6 and 9 are not anticipated by the cited references and are in condition for allowance. The applicant requests that the examiner withdraw the rejections of and allow claims 3, 6 and 9.

Claim 5 was rejected based on Tabor purportedly disclosing in column 9, lines 14-19 how the vibrating state can be predetermined in a certain range of lift, and this range is inherently bounded by a minimum lift and a maximum lift, and the bucket being within the predetermined segment is a necessary condition for causing the activation signal. Although this language as presented in the Office action is similar to that of claim 5, it is not found in Tabor. The cited passage of Tabor merely discloses, as mentioned above with reference to claim 1, that the system controller 280 is capable of determining when it is necessary to enter the vibrating

state automatically without receiving any command from the operator (e.g. based upon signals from one or more sensors). This disclosure is simply and plainly lacking in any of the specific subject matter of claim 5.

For at least this illustrative reason, claim 5 is not anticipated by the cited references and is in condition for allowance. The applicant requests that the examiner withdraw the rejection of and allow claim 5.

Claims 17, 18, 36 and 37 were rejected based on Tabor allegedly disclosing in column 9, lines 1-14, the joystick as being oriented for a predetermined amount of time. However, this is simply not the case; this passage does not mention a joystick at all; nor is there any apparent disclosure in Tabor of a joystick involved in an activation state for causing an activation signal for causing the attachment member to vibrate automatically, as in claims 17 and 36. This is in stark contrast to claims 17 and 36, which involve the activation state, for causing an activation signal for causing the attachment member to vibrate automatically, comprising the joystick being oriented in a predetermined orientation for a predetermined amount of time. It also stands in stark contrast to claims 18 and 37, wherein the activation state, for causing an activation signal for causing the attachment member to vibrate automatically, comprising the joystick being jiggled. There is simply no disclosure in Tabor of the joystick being oriented in a predetermined orientation for a predetermined amount of time, or of jiggling the joystick, to cause a vibration activation state.

For at least these additional illustrative reasons, claims 17, 18, 36 and 37 are not anticipated by the cited references and are in condition for allowance. The applicant requests that the examiner withdraw the rejection and allow these claims.

CLAIMS 4, 7, 10-14, 23, 28, 31, 33 AND 41 ARE NOT MADE OBVIOUS BY TABOR

Claims 4, 7, 10-14, 23, 28, 31, 33 and 41 were rejected under 35 U.S.C. 103(a) under the single reference of Tabor, each with elements concededly missing from Tabor but discerned, without another cited reference, to have been obvious. Claims 4, 7, 10-11, 13-14, 23, 28, 31, 33 and 41 are each based on either claim 1, 8, or 34. The obviousness-based rejection of

these claims assumes that Tabor discloses certain elements comprised in claims 1, 8, and 34 that Tabor did not in fact disclose, as discussed above with reference to the §102 rejections of these claims. Similarly, claim 12 includes elements not taught or suggested by Tabor's mere invitation to a fishing expedition by suggesting the possibility of unnamed and unelaborated signals or means for a system controller to determine when to enter a vibrating state. The failure of Tabor to disclose those elements suffices to show also that the claims dependent on claims 1, 8, and 34 are not rendered obvious by Tabor, since they each include elements not shown to be disclosed or suggested by Tabor.

Additionally, the assertions that additional elements concededly not disclosed by Tabor are purportedly obvious in the absence of other cited references, do not meet the test for establishing *prima facie* obviousness. It is asserted in the Office action that it would have been obvious to modify the system of Tabor to cover a great variety of subject matter from claims 4, 7, 10-14, 28, 31, and 33, and this conclusion rests on the argument that Tabor states in column 9, lines 14-19 how the vibrating state can be predetermined, and that this somehow suggests in one way or another various elements among great variety of subject matter from claims 4, 7, 10-14, 28, 31, and 33. However, the cited passage of Tabor does not in fact disclose how or under what specific conditions a vibrating state may be automatically engaged; nor does Tabor include any specific evidence supporting suggestions of any of the specific elements of claims 4, 7, 10-14, 28, 31, and 33 that it is purported in the Office action to suggest. Instead, the only apparent source for this subject matter is hindsight from the applicant's claims. Indeed, the great variety of different elements from claims 4, 7, 10-14, 28, 31, and 33 weighs heavily and persuasively against the contention that the entirety of this great variety of specific elements were all suggested by the single, brief, generalized suggestion of column 9, lines 14-19 of Tabor.

For at least these additional illustrative reasons, claims 4, 7, 10-14, 28, 31, and 33 therefore define subject matter not rendered obvious by Tabor, in addition to the subject matter of their parent claims not made obvious by Tabor. The applicant therefore submits that these claims are in condition for allowance, and requests that the examiner withdraw the rejection and allow these claims.

CLAIM 21 IS NOT RENDERED OBVIOUS BY TABOR AND ORBACH

Claim 21 was rejected under §103(a) due to Lee combined with Orbach, as well as under §103(a) due to a combination of Tabor and Orbach. However, the applicant maintains that Lee and Orbach do not render claim 21 obvious, as discussed in the applicant's previous response; nor do Tabor and Orbach render claim 21 obvious. Specifically, there would have been no motivation to combine the disclosures of Lee and Orbach or Tabor and Orbach, and furthermore, Lee and Orbach are directed to different purposes and teach away from each other, as is true also of Tabor and Orbach. Since "[v]irtually all inventions are combinations... of old elements" (Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161, 1179 (Fed Cir. 1991) (cit. omitted)), these distinctions of motivation to combine and teaching away deserve great weight in distinguishing combinations of elements that are inventive.

For example, neither Lee and Orbach, nor Tabor and Orbach, nor the common knowledge of those in the art or the nature of the problem to be solved, include a suggestion to combine the disclosures of these references as demonstrated by a specific factual inquiry of objective evidence. Even if Lee and Orbach or Tabor and Orbach were to disclose or suggest every element of claim 21 between the two of them, the claim is not shown to be obvious without such a specific fact finding that a person skilled in the art at the time of the invention of claim 21 would have had a motivation to combine the teachings of these two references. Such a specific fact finding from objective evidence has not been shown.

Furthermore, Orbach teaches away from both Lee and Tabor, and from the invention of claim 21, providing compelling evidence that a person of ordinary skill in the art at the time that claim 21 was invented would not have had motivation to combine the Lee and Orbach references or the Tabor and Orbach references. Specifically, Orbach discloses a system for restricting motion of an implement while the implement is inactive and while a machine on which it is mounted is traveling. It deals with preventing undesirable motions of an implement. In contrast, claim 21 includes an automatic vibration mechanism for causing the attachment member to vibrate automatically in response to an activation signal, wherein the automatic vibration mechanism comprises an algorithm. As defined by the claim language and as described

in the specification, the subject matter of claim 21 is advantageous for actively working with the attachment member and causing the attachment member to vibrate. Orbach teaches stopping any motions of an implement, thereby not only teaching away but teaching quite the opposite of actively vibrating an implement as taught for the invention of claim 21. Orbach is thus very different in mechanism and in purpose from the teachings of claim 21, and from the teachings of Lee and Tabor; the automatic vibration of a working member taught by both Lee and Tabor would work directly contrary to the purposes of Orbach. Since “[i]t is improper to combine references where the references teach away from their combination (MPEP §2145(X)(D)(2); In re Grasselli, 218 USPQ 769, 779 (Fed. Cir. 1983))”, neither the combination of Lee and Orbach nor the combination of Tabor and Orbach properly show that claim 21 would have been obvious. On the contrary, claim 21 describes a new and unobvious invention.

CLAIMS 1, 3-11, 13-28, 31, AND 33-43 ARE IN CONDITION FOR ALLOWANCE

As explained above, the applicant submits that claims 1, 3-11, 13-28, 31, and 33-43 are in condition for allowance. The applicant respectfully requests that the rejection of these claims be reconsidered, and that claims 1, 3-11, 13-28, 31, and 33-43 be allowed.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Bryan F. Erickson, Reg. No. 51,655
Suite 1400 - International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222
Fax: (612) 334-3312

BFE